

REMARKS

Applicant has studied the Office Action dated December 18, 2003, and has made amendments to the claims. Claims 1-9 and 11-16 are pending. Claims 1-9 and 11 have been amended. Claim 10 has been canceled without prejudice. New claims 12-16 have been added. Claims 1, 4, 7 and 14 are independent claims. No new matter has been added. It is submitted that the application, as amended, is in condition for allowance. Reconsideration and reexamination are respectfully requested.

Claim Amendments

The amendments to claims 1-3, 5, 6, 8, 9 and 11 were made to correct typographical errors and more clearly define the invention. The amendments are not related to the patentability of the claims.

§ 102 Rejection

Claims 4-7, 9 and 11 were rejected under section 102(e) as anticipated by Ito et al. (US 6,160,778). This rejection is respectfully traversed.

A proper rejection for anticipation under § 102 requires complete identity of invention. The claimed invention, including each element thereof as recited in the claims, must be disclosed or embodied, either expressly or inherently, in a single reference. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991); Standard Havens Prods., Inc. v. Gencor Indus., Inc., 953 F.2d 1360, 1369, 21 U.S.P.Q.2d 1321, 1328 (Fed. Cir. 1991).

With this paper, independent claims 4 and 7 have been amended to recite that a command for formatting the recording medium is received and that "replacing the defective areas with corresponding spare areas" (claim 4) and "a first mode for defect replacement" (claim 7) are performed during the formatting. It is respectfully submitted that it is therefore also inherently recited that "confirming whether or not an error has occurred" (claim 4), "adjusting the recording capacity of the recording medium" (claim 4), "determining if an error occurred during the first mode" (claim 7), "stopping the first defect replacement if an error occurred and checking un-slipped segments" (claim 7) and "reserving an area corresponding to the number of un-slipped segments" (claim 7) are also performed during the formatting. Support for the amendments is found in the specification as originally filed at page 9, ll. 16-21 and FIG. 6.

It is respectfully submitted that Ito et al. fails to disclose that a command for formatting the recording medium is received, as recited in independent claims 4 and 7. It is further respectfully submitted that Ito et al. fails to disclose that “replacing the defective areas with corresponding spare areas,” “confirming whether or not an error has occurred,” and “adjusting the recording capacity of the recording medium” are performed during the formatting, as recited in independent claim 4. Moreover, it is respectfully submitted that Ito et al. fails to disclose that “a first mode for defect replacement,” “determining if an error occurred during the first mode,” “stopping the first defect replacement if an error occurred and checking un-slipped segments,” and “reserving an area corresponding to the number of un-slipped segments” are performed during the formatting, as recited in independent claim 7.

It is respectfully noted that Ito et al. discloses the replacement of defective areas in the SDL and defines “SDL 13” as “used to manage defective sectors which are detected during use of the disk 1 by the user.” Ito et al. at col. 10, ll. 19-20. It is further respectfully noted that Ito et al. discloses the replacement of defective areas in the SDL when “data is recorded” as opposed to during the formatting of the disk. See Ito et al. at col. 13, ll. 59-67, col. 14, ll. 11-33 and ll. 49-53, and col. 15, ll. 1-11. It is respectfully submitted that nowhere in Ito et al. is a command for formatting the recording medium disclosed. Therefore, it is respectfully asserted that Ito et al. does not disclose the performance of any steps during the formatting of the disk as recited in independent claims 4 and 7.

It is respectfully asserted that independent claims 4 and 7 are allowable over Ito et al. because the reference fails to disclose each element recited therein. It is further respectfully asserted that claims 5 and 6, which depend from claim 4, and claims 9 and 11, which depend from claim 7, also are allowable over the cited reference.

§ 103 Rejection

Claims 1, 3 and 7-11 were rejected under 35 U.S.C. § 103(a) as unpatentable over Yamamuro (US 5,956,309) in view of Ito et al. This rejection is respectfully traversed.

With regard to the rejection of independent claim 1, the Examiner appears to agree, on page 5 of the Office action, that Yamamuro fails to disclose “determining [whether] a slipping replacement error [occurred] in response to the number of PDL [entries]; checking a number of un-slipped PDL [entries if a slipping replacement error occurred]; and adjusting the recording capacity of the recording medium [based on] the number of un-slipped PDL [entries],” as recited by independent claim 1. The Examiner asserts that these features are well-known in the art “as

evidenced by Ito et al.” See Office action at page 5. However, it is respectfully submitted that Ito et al. also fails to disclose these limitations.

The assertions made by the Examiner with respect to Ito et al. and independent claim 1 are essentially the same as those contained in the prior Office action mailed on March 27, 2003 in which the Examiner rejected independent claims 1-3 and 7-11 under section 103(a) as unpatentable over Ito et al. in view of ordinary skill in the art at the time of the invention. Therefore, the Examiner's comments with respect to the Applicant's response to the prior Office action are pertinent to the present Office action.

The Examiner asserts in the present Office action at page 8 that “it is noted that the features upon which the applicant relies (i.e. ‘(1) determining a slipping replacement error in response to the number of PDL registrations, (2) checking a number of un-slipped (un-replaced) PDL registrations; and (3) adjusting the recording capacity of the recording medium by the number of un-replaced and un-slipped (un-replaced) PDL registrations if the slipping replacement error has occurred’) are not recited in the rejected claim(s).” Applicant respectfully disagrees with the Examiner's assertion with regard to the arguments presented in the previous Office action.

The features which the Examiner asserts are “not recited in the rejected claim(s)” **are recited in independent claim 1** and are the same features of claim 1 that the Examiner again asserts are disclosed by Ito et al. Therefore, the arguments put forth in the response to the previous Office action are reiterated and it is respectfully requested that the Examiner consider those arguments.

Furthermore the Applicant's arguments herein with respect to the section 102 rejection of independent claims 4 and 7 are applicable to the rejection of independent claim 1. It is respectfully submitted that the disclosure in Ito et al. is with regard to “SDL” instead of “PDL,” as recited in independent claim 1. It is respectfully noted that Ito et al. defines “PDL” as “used to manage defective sectors which are detected during a pre-shipping inspection of the disk.” Ito et al. at col. 10, ll. 15-19. It is further respectfully submitted that nowhere in Ito et al. is there any disclosure with respect to determining whether a slipping replacement error occurred “in response to the number of PDL entries,” checking a number of “un-slipped PDL entries if a slipping replacement error occurred,” or adjusting the recording capacity of the recording medium “based on the number of un-slipped PDL entries” as recited in independent claim 1.

It is respectfully asserted that independent claim 1 is allowable over the combination of the cited references because neither Yamamuro nor Ito et al. discloses the noted limitations

recited therein. It is further respectfully asserted that claims 2 and 3, which depend from claim 1, also are allowable over the cited references.

With regard to the rejection of independent claim 7, as was previously noted, independent claim 7 has been amended to recite that a command for formatting the recording medium is received and that "a first mode for defect replacement" is performed during the formatting and, therefore, it is inherently recited that "determining if an error occurred during the first mode," "stopping the first defect replacement if an error occurred and checking un-slipped segments," and "reserving an area corresponding to the number of un-slipped segments" are also performed during the formatting.

It is respectfully noted that the Examiner appears to agree, on page 6 of the Office action, that Yamamuro fails to disclose "determining if an error occurred during the first mode, wherein the error is caused when a size of the defective segments exceeds the spare area; stopping the first defect replacement if an error occurred and checking un-slipped segments by determining a number of the defective segments not subjected to the first defect replacement due to insufficient spare area; and reserving an area corresponding to the number of un-slipped segments, thereby managing the un-slipped segments continuously," as recited in independent claim 7.

It is further respectfully submitted that nowhere in Yamamuro is a command for formatting the recording medium disclosed, as recited in independent claim 7 and therefore, that Yamamuro fails to disclose the performance of any steps during the formatting of the disk as recited in independent claim 7.

As previously respectfully submitted with regard to the section 102 rejection of independent claim 7, Ito et al. also fails to disclose a command for formatting the recording medium and, therefore, also fails to disclose the performance of any steps during the formatting of the disk as recited in independent claim 7.

It is respectfully asserted that independent claim 7 is allowable over the combination of the cited references because neither Yamamuro nor Ito et al. discloses the noted limitations recited therein. It is further respectfully asserted that claims 8, 9 and 11, which depend from claim 7, also are allowable over the cited references.

New Claims

With this paper, Applicant has added new claims 12-16. Support for the new claims is found in the application as originally filed.

It is respectfully asserted that new independent claim 14, which recites receiving a command for formatting the recording medium, is in condition for allowance for the same reasons put forth herein with respect to independent claims 4 and 7. It is further respectfully asserted that claims 12 and 13, which depend from claim 7, and claims 15 and 16, which depend from claim 14, also are in condition for allowance for the same reasons put forth herein with respect to independent claims 7 and 14, respectively.

CONCLUSION

In view of the above remarks, Applicant submits that the present Amendment places claims 1-9 and 11-16 of the present application in condition for allowance. Reexamination and reconsideration of the application, as amended, are requested.

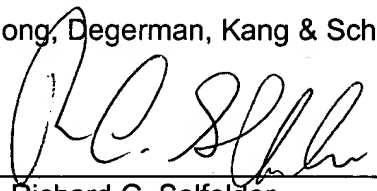
No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California, telephone number (213) 623-2221 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

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